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10/736,470	12/15/2003	Steven Tischer	030536 (BLL-0162)	3487
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EXAMINER				
LEVINE, ADAM L				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/736,470

**Applicant(s)**

TISCHER, STEVEN

**Examiner**

ADAM LEVINE

**Art Unit**

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 8-15 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 8-15 and 19-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10 October 2008 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 10, 2008, has been entered in accord with the request for continued examination filed December 11, 2008.

Applicant's amendments and remarks filed October 10, 2008, are responsive to the office action mailed August 11, 2008. Claims 1-5, 8-15, and 19-21 were previously pending. Specification paragraphs 0004-0005 and 0026-0027 are amended. Drawing figure 3 is amended. No claims are amended and no claims are cancelled, therefore claims 1-5, 8-15, and 19-21 remain currently pending and are considered in this office action.

### ***Response to Amendment***

#### ***Pertaining to rejection under 35 USC 112, second paragraph, in the prior office action***

Claims 1-5, 8-15, and 19-21 were rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. The reply filed May 8, 2008, indicated that the third and master data sets are

described in specification paragraphs 0026 and 0027. This statement indicated that the invention was different from that defined in the claim(s) because the third and master data sets described in the claims were different in both function and purpose from the third and master data sets described in the specification. This has been alleviated by the amendments to the specification and drawing figure, however, since the third and master data sets described in the claims were different in both function and purpose from the third and master data sets previously described in the specification, the amendments to the specification and drawing figure have introduced new problems.

### ***Response to Arguments***

#### **Pertaining to rejection under 35 USC 112, first paragraph, in the previous office action**

Applicant's arguments filed October 10, 2008, have been fully considered but they are not persuasive. Claims 1-5, 8-15, and 19-21 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification describes a third data set generated based on similar first and second attributes from first and second data sets. The master data set is a compilation of the common attributes gathered from accumulated third data sets. See Original Specification filed April 28, 2003, paragraphs 0023-0027. The applicant has modified this by changing the third data set into another instance of the same type of data set

that was previously defined as the first and second data sets described in the specification, and by changing the master data set into one that reflects the function previously performed by the third data set. The claims now are directed to a third data set that is not derived from similar first and second attributes from first and second data sets, but is derived in a manner similar to that originally practiced by only the first and second data sets. The claims are also now directed to a master data set that is generated in a manner similar to that only disclosed in the specification as being practiced by the third data set. The essential function and purpose of the master set disclosed in the specification is not claimed.

Applicant argues that there was an inconsistency in the specification and that the specification was actually referring to the same data set by two different names, "third data set" and "master data set." A reading of the relevant paragraphs of the specification however shows that they are in fact different data sets with different forms and functions. Even if this different meaning was unintentional, to change it so significantly now creates a new matter situation. Applicant in making this argument disregards the essential purposes and functions of the respective data sets. The first and second data sets could represent any number of actual data sets (see figure 2). This is also the case in the prior art. The difficulty is that the applicant is now attempting to change the essential purposes and functions of the disclosed third and master data sets. As now claimed, the master data set has taken the place of what was the third data set in the specification, and the third data set is merely a redundancy of the data sets previously claimed as the first and second sets. Although applicant argues that the

absence of a third data set in figure 2 supports the notion that it is the same as a master data set, the description in specification paragraphs 0023-0027 indicates that the third data set is an intermediate data set performing an intermediary functional step in between the first two data sets and the master data set. As an intermediary step appearing in figure 3, it is not necessary to show it in figure 2.

It is here noted perhaps tangentially that once a range of multiple data sets with the same function is disclosed, increasing or decreasing the specific number is not distinguishing. Applicant originally changed the purpose of the third data set and inserted the fourth in an attempt to overcome the prior art but this attempt was ineffective. The prior art reference explicitly discloses a virtually limitless number of potential data sets.

*Pertaining to rejection under 35 USC 102(b) in the previous office action*

Applicant's arguments filed October 10, 2008, have been fully considered but they are not persuasive. Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Applicant cites out of all context a single three line portion of the 63 page reference (a portion not even relied upon in the rejection) and attempts to mischaracterize the entire reference on the basis of this largely innocuous and irrelevant notation. The remarks do not address the relevant portions of the prior art reference as set forth below.

***Drawings***

1. **The drawings were received on October 10, 2008.** These drawings are objected to because they introduce new matter to the specification as further discussed below. They are also objected to because in addition to Replacement Sheets containing the corrected drawing figure(s), applicant is required to submit a marked-up copy of each Replacement Sheet including annotations indicating the changes made to the previous version. The marked-up copy must be clearly labeled as "Annotated Sheets" and must be presented in the amendment or remarks section that explains the change(s) to the drawings. See 37 CFR 1.121(d)(1). Failure to timely submit the proposed drawing and marked-up copy will result in the abandonment of the application.

***Specification***

2. **The amendment filed October 10, 2008, is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure.** 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The replacement of "third data set" with "master data set" in figure 3, and specification paragraphs 0004-0005 and 0026-0027. The original specification describes a third data set generated based on similar first and second attributes from first and second data sets, and describes the master data set as a compilation of the common attributes gathered from accumulated third data sets. See Original Specification filed April 28, 2003, paragraphs 0023-0027. The applicant has modified

this in the claims by changing the third data set into another instance of the same type of data set that was previously defined as the first and second data sets described in the specification, and in the specification by changing the master data set into one that performs both its original function and the function previously performed by the third data set. The claims are now directed to a master data set that is generated in a manner similar to that only disclosed in the original specification as being practiced by the third data set. The essential function and purpose of the master set disclosed in the specification is not claimed.

Applicant argues that there was an inconsistency in the specification and that the specification was actually referring to the same data set by two different names, "third data set" and "master data set." A reading of the relevant paragraphs of the specification however shows that they are in fact different data sets with different forms and functions. Even if this different meaning was unintentional, to change it so significantly now creates a new matter situation. Applicant in making this argument disregards the essential purposes and functions of the respective data sets. The first and second data sets could represent any number of actual data sets (see figure 2). This is also the case in the prior art. The difficulty is that the applicant is now attempting to change the essential purposes and functions of the disclosed third and master data sets. As now described, the master data set has taken the place of what was originally the third data set, and the third data set has disappeared from the description and in the claims is now merely a redundancy of the data sets previously claimed as the first and second sets. Although applicant argues that the absence of a third data set in figure 2



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supports the notion that it is the same as a master data set, the description in specification paragraphs 0023-0027 indicates that the third data set is an intermediate data set performing an intermediary functional step in between the first two data sets and the master data set. As an intermediary step appearing in figure 3, it would not have been necessary to show it in figure 2. It is again noted that even if the different original meaning was unintentional, to change it now creates a new matter situation.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. **Claims 1-5,8-15, and 19-21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification describes a third data set generated based on similar first and second attributes from first and second data sets. The master data set is a compilation of the common attributes gathered from accumulated third data sets. The applicant has amended the claims to change the third data set into one that functions similarly to the first and second data sets described in the specification and to create a master data set

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that reflects the function previously performed by the third data set. This is new matter.

The essential purpose of both the third and master data sets have been changed and the now claimed invention was not disclosed in the originally filed specification.

***Claim Rejections - 35 USC § 102***

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**4. Claims 1-5, 8-15, and 19-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Herz (Paper # 060324; US Patent No. 6,029,195).**

Herz teaches a system for comparing attributes of multiple data sets to determine similarities and then create new data sets based on the similarities. Herz further teaches:

- determining when the entity selects a first service or product: generating a first data set having a first attribute associated with the first service or product (see at least abstract, fig.10); wherein the first data set is generated by a digital video recording device and includes a unique identifier associated with an entity, a date, a time and a title of a program or movie selected by the entity for recording on the digital video recording device (see at least abstract, column 32 line 65-column 33 line 59, column 43 line 53-column 44 line 49, column 39 line 57 – column 40 line 33. Please note: passages show that electronic media includes video and that video recording devices are among the potential devices that generate profile data. Please note: The particular information included in the data set is descriptive material and is not functionally involved in the recited steps

of the method. Because it has no functional role in the method it is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106); first device configured to determine whether the entity purchases, submits an order for the first service or product (see at least column 5 lines 36-45, column 18 line 40-column 19 line 7, column 68 lines 5-10, column 77 lines 17-47); a first network device generates the first data set (see at least abstract, fig.1,2); a first device configured to determine when the entity selects a first service or product and generating a first data set having a first attribute associated with the first service or product (see at least abstract, fig.1,2,10,12); first device comprises one of a computer, a cellular phone, or a digital video recording device (see at least fig.1,2);

- determining when the entity selects a second service or product: generating a second data set having a second attribute associated with the second service or product (see at least abstract); wherein the second data set is generated by a personal computer, the second data set including a unique identifier associated with an entity, a data, a time, and a web address accessed by the personal computer (see at least abstract, figs.1,2; column 7 lines 19-51, column 12 line 61 – column 13 line 41, column 32 line 65-column 33 line 59, column 67 line 30 – column 68 line 21, column 72 line 65 – column 73 line 42); a second device configured to determine when the entity selects a second service or product and

generating a second data set having a second attribute associated with the second service or product (see at least abstract, figs.1,2,10);

- determining when the entity selects a third service or product: generating a third data set having a third attribute associated with the third service or product (see at least abstract); wherein the third data set is generated by a store computer, the third data set including a unique identifier associated with an entity, a date, a time, and a title of an item purchased by the entity (see at least abstract, figs.1,2; column 7 lines 19-51, column 12 line 61 – column 13 line 41, column 32 line 65- column 33 line 59, column 67 line 30 – column 68 line 21, column 72 line 65 – column 73 line 42);
- generating a master data set based on the first, second, and third attributes: when a portion of data associated with the first attribute matches a portion of data associated with the second attribute and third attribute (see at least abstract, column 5 lines 6-20, column 26 lines 2-21); a fourth network device generates the master data set (see at least abstract, figs.1,2); a fourth device configured to generate a master data set based on the first, second, and third attributes when a portion of data associated with the first attribute is substantially similar to a portion of data associated with the second and third attributes (see at least abstract, figs.1,2,10; column 5 lines 6-20, column 26 lines 2-21); fourth device is operably associated with a grid computer network (see at least abstract, figs.1,2); fourth device comprises a computer server communicating with the first, second, and third devices (see at least figs.1,2);

- the master data set including a plurality of potential interest elements: based on a number of matches between the first, second, and third attributes (see at least abstract, figs.10-15, column 2 line 39 – column 3 line 10);
- ranking the potential interest elements in the master data set: based on the number of matches: between the first, second and third attributes (see at least abstract, figs. 11-12, 16; column 4 lines 4-27);
- the data associated with the first attribute comprises textual data: and the data associated with the second attribute comprises textual data and the portion of the data associated with the third attribute comprises textual data (see at least abstract, column 5 lines 6-20, column 9 lines 19-30, column 77 lines 17-47); generating the master data set based on the first, second, and third attributes includes determining whether at least a portion of the textual data of the first attribute is identical to at least a portion of the textual data of the second attribute and third attribute and forming the master data set having a fourth attribute containing at least a portion of textual data from one of the first, second, and third attributes (see at least abstract, column 5 lines 6-20, column 77 lines 17-47);
- entity comprises one of a person or a group of people: (see at least abstract, column 9 lines 31-42. Please note: the identity of the entity has no functional role in the method and a person or group of people are themselves not patentable subject matter.).

- A storage medium encoded with machine-readable computer program code for generating data sets associated with an entity: (see at least column 9 lines 19-30).
- generating a plurality of historic data sets by monitoring activities of a legal entity: (see at least fig.10, column 77 lines 17-47); identifying a plurality of attributes contained in the plurality of historic data sets (see at least figs.5,10, column 77 lines 17-47); determining a plurality of values wherein each value is associated with one attribute of the plurality of attributes and corresponds to a number of historic data sets of the plurality of historic data sets containing the one attribute (see at least fig.12); determining a plurality of dynamic data sets containing the attributes wherein the plurality of dynamic data sets are ranked based on the plurality of values (see at least abstract, fig.12, column 18 line 40-column 19 line 7, column 19 line 29-column 20 line 22, column 77 lines 48-67); iteratively generating the plurality of historic data sets by monitoring activities of the legal entity (see at least abstract, figs.5,10; column 20 line 47-column 21 line 4).

Pertaining to method claims 1-5 and 8-9

Rejection of claims 1-5 and 8-9 is based on the same rationale as noted above.

Pertaining to encoded storage medium claim 21

Rejection of claim 21 is based on the same rationale as noted above.

Examiner cites particular columns and line numbers in the reference as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within claims, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the reference in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ADAM LEVINE whose telephone number is (571)272-8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571.272.6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey A. Smith/  
Supervisory Patent Examiner, Art  
Unit 3625

Adam Levine  
Patent Examiner  
March 11, 2009